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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
VETTER, DANIEL				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,497

Applicant(s)

LUBART, BARRY P.

Examiner

DANIEL P. VETTER

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 40, 41, 44, and 46-50 were previously pending. Claims 40 and 41 were amended, and claims 44 and 46-50 were canceled in the reply filed February 10, 2009. Claims 40 and 41 are currently pending.

Response to Arguments

2. Examiner maintains that the contents of the naming profile are non-functional descriptive material. As claimed, the naming profile is a set of addresses. Addresses alone are not functional. Applicant argues that the return to address is functional because "it conveys information about where to return the mail if undeliverable." Remarks, page 7. This is not present in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant sets forth a number of other alleged functions that are also not recited in the claims. See Remarks, page 8. As drafted, the return address is unrelated to any other part of the claimed invention. The descriptive text identifying the return address does not exploit or interrelate with the underlying structural elements and, therefore, is not "functionally related to the substrate." See *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The claims also do not even seem to require that the addressee address and the return address are different, as alleged in the Remarks, page 9. It is well-known that addresses such as physical delivery addresses serve as both an addressee address and the return address. Examiner also maintains that even if the return address was considered functional descriptive material, its inclusion would be obvious for the reasons stated in the rejections below.

3. Examiner notes as a matter of claim construction that while the Specification discloses one of the principal uses of the pseudo name is to replace a physical address

used in mail processing, the claims as currently drafted merely use the pseudo name for billing purposes and passive display on the mail piece. This function of the pseudo name has not been read into the claims.

4. Applicants arguments based on the newly added limitations are considered moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the disclosure generally describes the principles of pseudo names, it does not "a first franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first pseudo name corresponding to an entity to be billed for charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name." No forms of the word "trust" appear in the disclosure. It is not clear what in the disclosure would constitute a trusted pseudo name. There is not support therefore for a list of trusted pseudo names, for another entity being billed for charges incurred by a trusted pseudo name, and at least one trusted pseudo name being the second pseudo name.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 40 and 41 recite "a first franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first pseudo name corresponding to an entity to be billed for charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name." The effect of the term "trusted" is unclear. No forms of the word "trust" appear in the disclosure, and it is not clear what would be the difference between a list "trusted" pseudo names and another list of pseudo names. Accordingly, the public is not properly apprised as to the scope of the claims and thus what would constitute infringement.

10. Claim 40 recites a "means for registering a second pseudo name." This element is recited distinctly from the previously "means for registering a first pseudo name." However, it is unclear if the corresponding structures in the specification for these § 112, sixth paragraph elements are actually different. Applicant has identified ¶¶ 0025, 42, and 47 as identifying the corresponding structure for the "means for registering a first pseudo name." Remarks, pages 4-5. However, there does not appear to be any corresponding structure for a "means for registering a second pseudo name" if it is indeed different from the "means for registering a first pseudo name."

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, et al., Intl. Pat. Pub. No. WO 02/51051 (Reference 1 of the IDS submitted

5/23/2005) in view of Dutta, U.S. Pat. Pub. No. 2003/0177021 (Reference A of the attached PTO-892) and Law, U.S. Pat. No. 7,058,586 (Reference A of the PTO-892 part of paper no. 20071119).

13. As per claim 40, Lorch teaches a system comprising: means for registering a first pseudo name and a first user profile associated with the first pseudo name (pg 11, lines 8-10, 18-21); means for registering a second pseudo name (pg 11, lines 8-10, 18-21); the first user profile having: a first franking profile (pg 23, lines 8-11); a naming profile including an addressee address, the addressee address being one of a physical address, the first pseudo name, the second pseudo name and a third pseudo name (pg 19, lines 15-17; Fig. 3); means for filtering mail to be delivered to an alternate address (pg 22, lines 7-20); and means for displaying the first pseudo name on the mail object (Fig. 1; pg 11, lines 12-14).

Lorch does not explicitly teach that the naming profile also includes a return to address. However, this difference is solely found in the non-functional descriptive material of the stored address data itself. Non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The return to address included in the user profile has no functional relationship with any other recited element of the claim, and thus is not "functionally related to the substrate." See *id.*

Moreover, even if a functional relationship between the return address and the rest of the invention existed, its inclusion would still be obvious based upon Lorch's disclosure. Lorch teaches that a sender name and physical address is placed on the mail object to identify a sender of the mail object (Fig. 1), and that recipient/sender addresses share the same format and represent physical locations (Fig. 1). Therefore, a sender address can also serve as a recipient address without any modification. Additionally, the usefulness of the pseudo name as suggested by Lorch is applicable for

sender (return) as well as recipient addresses. The advantage of the pseudo name is that it allows physical address delivery without the other party knowing the physical address (pg 16, lines 12-14). This premise is also applicable to return mail, as senders may wish to keep their physical address unknown for the same reasons as recipients, but may still desire return correspondence from the initial recipient. Additionally, this allows businesses to use an easy-to-remember return address for consumer response correspondence, a use explicitly suggested by Lorch (pg 35, lines 3-14). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to include a return to address into the user profile because this is simply a combination of old elements already known in the art. In the combination no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

Similarly, while Lorch teaches both a pseudo name and a return field, it does not explicitly teach that the address in the return field is a pseudo name rather than a physical address. Thus, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the physical sender address in the return field with a pseudo name. Both recipient and sender addresses share similar characteristics and functions. They are formatted in the same manner and both identify physical locations. The same single address often serves as both an addressee address and return address. Figure 3b of the present invention also shows the interchangeability of a pseudo name with a return address. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a sender pseudo name because it is merely the simple substitution of one known element for another that could be implemented through routine engineering to produce only predictable results. Moreover, the usefulness of the pseudo name as suggested by Lorch is applicable for sender (return) as well as recipient addresses. The advantage of the pseudo name is that it allows physical address delivery without the other party knowing the physical address (pg 16, lines 12-14). This premise is also applicable to return mail, as senders

may wish to keep their physical address unknown for the same reasons as recipients, but may still desire return correspondence from the initial recipient. Additionally, this allows businesses to use an easy-to-remember return address for consumer response correspondence, a use explicitly suggested by Lorch (pg 35, lines 3-14).

While Lorch generally teaches recipient billing (pg 37, lines 11-13), it does not explicitly teach a first franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first name corresponding to an entity to be billed for charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name; and similarly, means for billing the entity corresponding to the first name for services provided to the second pseudo name. Dutta teaches a franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first name corresponding to an entity to be billed for charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name; and similarly, means for billing the entity corresponding to the first name for services provided to the second pseudo name (¶¶ 0025, 29-31). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings because this is merely a combination of old elements in the art of mail processing. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Examiner notes that while Dutta does not teach that the first name is a pseudo name, this teaching is supplied by the base reference. Also, examiner notes that Dutta teaches the naming profile's return address and the return address pseudo name missing from Lorch as detailed above (¶¶ 0025, 29-31; Fig. 2); which would have been obvious to incorporate for the same reason that it is merely a combination of old elements.

Lorch does not teach means for restricting mail delivery to receive mail from a first list of names; and that the means for filtering mail is from a second list of names; which are taught by Law (col. 4, lines 37-61). It would have been prima facie obvious to

one having ordinary skill in the art at the time of invention to incorporate the above teachings because this is merely a combination of old elements in the art of mail processing. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Examiner notes that for the § 112, sixth paragraph elements recited above, the corresponding structure disclosed in the Specification (i.e., hardware programmed with suitable instructions for performing the function) is the same as that disclosed in each of the above references.

14. As per claim 41, Lorch in view of Dutta and Law teaches a computer readable medium having a program for the mail services detailed in claim 40 as set forth above (see Lorch, pg 25, lines 5-8; Dutta, ¶¶ 0032-33; Law, col. 3, lines 42-46).

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628